

REMARKS

Upon entry of the foregoing Amendment, claims 1, 3-6, 8-9, 12-24, 26-38, 40-42, 44-45, 48, and 55-56 are pending in the application. Claims 1, 4, 12-15, 17-18, 21-23, 27-29, 33, 38, 42, and 48 have been amended. No claims have been cancelled or newly added. Applicants believe that this Amendment does not add new matter. In view of the foregoing Amendment and the following Remarks, allowance of all the pending claims is requested.

PROCEDURAL ERRORS

At the outset, prior to discussing the substantive distinctions between the claimed invention and the references relied upon, Applicants note that the alleged rejections that the Examiner has set forth in the Office Action include several errors that render various rejections legally improper. Accordingly, should the Examiner modify any of the alleged rejections to ostensibly cure the errors discussed herein, Applicants submit that the next Office Action must not be made final because any such modifications would not have been necessitated by any of Applicants' amendments to the claims.

A. CLAIMS 14 AND 22

The Examiner has committed error that renders the alleged rejection against claims 14 and 22 improper. More particularly, the Examiner has rejected claims 14 and 22 as allegedly being unpatentable over U.S. Patent Application Pub. No. 2003/0089765 to Kovelakas ("Kovelakas") in view of U.S. Patent No. 6,233,565 to Lewis et al. ("Lewis"), while rejecting claims 13 and 15 (from which claims 14 and 22 respectively depend) as allegedly being unpatentable over Kovelakas and Lewis *in combination with* U.S. Patent No. 6,005,945 to Whitehouse ("Whitehouse"). As such, the Examiner has improperly rejected claims 14 and 22 because the Examiner cited Whitehouse in the alleged rejection against parent claims 13 and 15 without citing Whitehouse in the alleged rejection against claims 14 and 22. Accordingly, due at least to the Examiner's error in this respect, the Examiner has improperly rejected claims 14 and 22.

B. CLAIMS 15-24, 26-27, AND 30

The Examiner has committed error that renders the alleged rejection against claims 15-24, 26-27, and 30 improper. More particularly, Applicants note that the Examiner rejected claims 15-24, 26-27, and 30 as allegedly being unpatentable over only Kovlakas, Lewis, and Whitehouse. See Office Action, page 10, numbered ¶ 4. However, in the alleged rationale associated with claims 15-16, 23, and 30, the Examiner alleges that “Gordon”¹ discloses various features recited therein. See Office Action, pages 17, 20, 27, 29, and 33. As such, the Examiner has improperly rejected claims 15-16, 23, and 30 (in addition to claims 17-22, 24, and 26-27 that depend on claims 15 and 23) because Gordon was not cited among the references relied upon in the rejection thereof. Accordingly, due at least to the Examiner’s error in this respect, the Examiner has improperly rejected claims 15-24, 26-27, and 30.

C. CLAIM 18 AND 34

The Examiner has committed error that renders the alleged rejection against claims 18 and 34 improper. More particularly, the Examiner conceded that “Kovlakas does not specifically disclose” the various features recited therein without citing another reference or providing any rationale to allege that the features recited in claims 18 and 34 would have been obvious. Accordingly, due at least to the Examiner’s error in this respect, the Examiner has improperly rejected claims 18 and 34.

REJECTION UNDER 35 U.S.C. § 103

A. CLAIMS 1, 3-6, 8-9, 12, 14, AND 22

The Examiner has rejected claims 1, 3-6, 8-9, 12, 14, and 22 under 35 U.S.C. § 103 as allegedly being unpatentable over Kovlakas in view of Lewis. This rejection is improper and must be withdrawn for at least the reason that Kovlakas and Lewis, either alone or in combination, fail to disclose, teach, or suggest each and every feature of the claimed invention.

¹ Although the Examiner has failed to provide any details to identify “Gordon” other than citing passages that relate to what Gordon allegedly discloses, Applicants presume “Gordon” to be U.S. Patent No. 6,527,178 to Gordon et al., which the Examiner cited in prior Office Actions.

More particularly, Kovlakas and Lewis, either alone or in combination, fail to disclose, teach, or suggest “generating . . . a unique postage indicium in response to receiving a request for a postage purchase transaction, wherein the unique postage indicium contains a unique tracking identifier to track a mail piece delivery status within the United States Postal Service,” “retrieving . . . the mail piece delivery status associated with the unique tracking identifier” in response to a refund inquiry associated with the postage purchase transaction, and “refunding the postage purchase transaction based on the mail piece delivery status associated with the unique tracking identifier,” as recited in amended independent claim 1, for example.

The Examiner alleges that Kovlakas discloses “generating . . . a unique postage indicium in response to receiving a request for a postage purchase transaction, wherein the unique postage indicium contains a unique tracking identifier that provides a mail piece tracking capability within the United States Postal Service.” To support this allegation, the Examiner refers to passages in Kovlakas that describe encrypting and saving information that “uniquely” identifies a mail piece (e.g., a mailer, personal computer meter, and date and time when a postage indicium was produced), and further refers to passages in Kovlakas that describe “mailpiece identification data [] used to track whether the mailpiece has been mailed, which [the Examiner] interprets as tracking capability. Applicants disagree with the Examiner’s assessment for at least the reason that Kovlakas does not disclose, teach, or suggest that the “mailpiece identification data” described therein can be used “to track a mail piece delivery status within the United States Postal Service.”

Rather, to the extent that Kovlakas generally describes reconciling information that uniquely identifies a mail piece and validate postage evidence associated therewith “against centralized or distributed remote logs of postage transactions and tracking information” to determine whether a debited postage amount associated with the mail piece can be properly refunded, Kovlakas describes reconciling the unique identification information to determine “if the mail piece has already been *entered into the postal mailstream*” (¶ [0007]) (emphasis added). However, whether a mail piece has already entered into the postal mailstream raises a different question from whether the mail piece has been delivered following entry into the postal mailstream. For example, Applicants’ disclosure describes one potential scenario

relating to a postage refund inquiry where in response to a user submitting a query to determine the current delivery status associated with a package carrying a certain tracking identifier, the "USPS delivery status for the [] package presents the phrase 'Your item was accepted at 10 pm on August 21 in Palo Alto, CA 94301.' This phrase is misleading in that it infers that the USPS actually took possession of this package. In reality, it only indicates the date/time in which the tracking information was posted to the master tracking computer system" (page 69, line 19 - page 70, line 4).

On the other hand, using the "delivery status" associated with the tracking identifier may obviate these potential discrepancies because the package "will never achieve a status of 'delivered'" if the user never mailed a package with the tracking identifier (Applicants' disclosure, pages 67-68, Table 3 and page 68, lines 2-8). In other words, although a mailer, personal computer meter, and date and time associated with a postage indicium may be suitable to uniquely identify a particular mail piece, that information does not provide an ability "to track a mail piece delivery status" associated therewith. Applicants' disclosure describes in substantial detail how unique tracking identifiers that provide such a capability have distinct characteristics from postage indicia, whereby using unique tracking identifiers to detect copy fraud and validate refund inquiries may address many issues that would arise if postage indicia information alone was used to process refund inquiries and detect copy fraud. As such, because Kovlakas does not disclose, teach, or suggest the "mailpiece identification data" described therein being used "to track a mail piece **delivery status** within the United States Postal Service," the Examiner has improperly equated one with the other.

Lewis fails to cure the foregoing deficiencies of Kovlakas for at least the reason that although Lewis generally describes a system that can process postage refund requests (e.g., col. 13, Table II), Lewis does not describe any details that relate to conditions that control whether or not the refund requests can be properly granted, much less that the refund requests are conditioned on a "mail piece delivery status associated with [a] unique tracking identifier" contained in a postage indicium for which the refund was requested. As such, for at least these reasons, Lewis fails to cure the foregoing deficiencies of Kovlakas.

Accordingly, for at least the foregoing reasons, Kovlakas and Lewis, either alone or in combination, fail to disclose, teach, or suggest each and every feature recited in amended independent claim 1. The rejection is therefore improper and must be withdrawn.

Independent claim 15 has been amended to include features similar to those set forth in amended independent claim 1. Claims 3-6, 8-9, 12, 14, and 22 depend from and add features to amended independent claims 1 and 15. Thus, the rejection of these claims is likewise improper and must be withdrawn for at least the same reasons.

B. CLAIMS 13, 15-21, 23-24, 26-38, 40-42, 44-45, 48, AND 55-56

The Examiner has rejected claims 13, 15-21, 23-24, 26-38, 40-42, 44-45, 48, and 55-56 under 35 U.S.C. § 103 as allegedly being unpatentable over Kovlakas in view of Lewis and Whitehouse.² This rejection is improper and must be withdrawn for at least the reason that the references relied upon, either alone or in combination, fail to disclose, teach, or suggest each and every feature of the claimed invention.

More particularly, for at least the reasons discussed above, Kovlakas and Lewis, either alone or in combination, fail to disclose, teach, or suggest “generating . . . a unique postage indicium in response to receiving a request for a postage purchase transaction, wherein the unique postage indicium contains a unique tracking identifier to track a mail piece delivery status within the United States Postal Service,” “retrieving . . . the mail piece delivery status associated with the unique tracking identifier” in response to a refund inquiry associated with the postage purchase transaction, and “refunding the postage purchase transaction based on the mail piece delivery status associated with the unique tracking identifier,” as recited in amended independent claim 1, for example.

Whitehouse fails to cure the deficiencies associated with Kovlakas and Lewis because Whitehouse does not describe refunding a postage purchase transaction based on a “mail piece delivery status associated with a unique tracking identifier” created in the postage purchase transaction. Rather, Whitehouse generally describes refunding postage purchase transactions

² Applicants note that although the heading for this rejection omits claim 45, the Examiner has addressed claim 45 in the body of the rejection. See Office Action, pages 10 and 36. As such, Applicants are assuming that the Examiner’s omitting claim 45 from the heading for this rejection was a typographical error.

in scenarios where the USPS has not processed “an indicium with the date, meter number and serial number of the allegedly misprinted indicium” (col. 24, line 53 *et seq.*). However, amended independent claim 1 recites “a unique postage indicium” distinctly from “a unique tracking identifier” contained therein, whereby whether a postage purchase transaction may be eligible to receive a refund may depend on a mail piece delivery status associated with “***the unique tracking identifier.***” In contrast, Whitehouse describes refunding postage purchase transactions based on the status associated with a ***postage indicium***. As such, for at least the reason that Whitehouse does not describe refunding a postage purchase transaction based on a mail piece delivery status associated with a unique tracking identifier, Whitehouse fails to cure the deficiencies of Kovlakas and Lewis.

Accordingly, for at least the foregoing reasons, Kovlakas, Lewis, and Whitehouse, either alone or in combination, fail to disclose, teach, or suggest each and every feature recited in amended independent claim 1. Independent claims 15, 23, 28, 33, and 48 have been amended to include features similar to those set forth in amended independent claim 1. Claims 13, 16-21, 24, 26-27, 29-32, 34-38, 40-42, 44-45, and 55-56 depend from and add features to amended independent claims 1, 15, 23, 28, 33, and 48. Thus, the rejection of these claims is improper and must be withdrawn for at least the foregoing reasons.

CONCLUSION

Having addressed each of the foregoing rejections, Applicants respectfully submit that a full and complete response has been made to the outstanding Office Action. As such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Respectfully submitted,

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